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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 10/667,419
Filing Date: September 23, 2003
Appellant(s): BERENSTAIN ET AL.

Mark M. Friedman
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed May 13, 2007, appealing from the Office action mailed May 2, 2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

US 4,810,751 A	Jellinek et al.	3-1989
GB 2 292 082	Dewsbury, Neil	2-1996
US 5,935,880 A	Wang et al.	8-1999

WO 02/060702 A2 Dong et al. 8-2005

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1, 2, 4, 6-9, 13-15, 17-19, 21, 23-31, 33, and 34, are rejected under 35 USC 103(a) as being unpatentable over Dong et al. (WO 02/060702 A2) in view of Jellinek et al. (US 4,810,751 A).

Dong teaches a process for applying a finishing agent to a non-woven fabric. Reference is made to 12:3-14; 17:10-19:28; and Fig. 2 of Dong.

The process comprises, in a production line for producing the non-woven fabric, forming a wet-laid, non-woven fabric in an apparatus therefor. The non-woven is de-watered to a water content of from about 2% to 30% by weight. This range overlaps that of "greater than 10%" claimed by Appellant. In the case where a claimed range overlaps or lies inside ranges disclosed by the prior art, a *prima facie* case of obviousness exists. See MPEP 2144.05(I).

The non-woven is passed along a production line during which materials or ingredients may be added to the non-woven using, for example, a binder applicator. Since appellant defines a "finishing agent" as "any additive, coating, or colorant that may be added to non-woven fabric" (spec., 10:20-21), the non-limiting examples of colorants and surface active materials taught by this reference read on Appellant's claimed "finishing agent" and the non-limiting example of a binder applicator taught by this reference read on Appellant's claimed "finishing unit." Such additives may be

applied after de-watering (i.e., at a moisture content of between about 2% and 30%) and before, during, or after drying in the driers and ovens deployed in the production line.

Dong does not explicitly teach coverage of less than 100%. It is the Examiner's position that, because Dong teaches the production of decorative laminates, this would have suggested application of the dyes and pigments in any suitable and aesthetically desirable fashion and doing so would have been obvious to one of ordinary skill in the art. There is no evidence of record that the binder applicator taught by Dong requires 100% coverage.

Further, Dong does not explicitly teach application by rotary screen printing. Jellinek teaches that coating compositions may be applied to a variety of web substrates, including non-wovens, as a paste or a foam, utilizing rotary screen printing [4:27-51]. Consequently, it would have been obvious to one of ordinary skill in the art to modify the process of Dong utilize a rotary screen printer to apply the coating composition, motivated by the desire and expectation of successfully applying the coating to the non-woven web.

Claims 3, 5, 20, and 22, are rejected under 35 USC 103(a) as being unpatentable over Dong in view of Jellinek, as applied to claims 1 and 19, respectively, above, and further in view of Wang et al. (US 5,935,880 A).

The combined teaching of Dong in view of Jellinek are detailed above.

Neither of these references explicitly teaches that the non-woven is produced according to the process recited in these claims.

Wang teaches that the non-woven webs may conventionally be formed by wet-laid, air-laid (dry-laid), or hydro-entanglement processes [1:18-40].

It would have been obvious to one of ordinary skill in the art to modify the process of Dong in view of Jellinek so as to form the non-woven by any one of these conventional processes taught by Wang and to incorporate the apparatus therefor as part of the production line. One of ordinary skill in the art would have been motivated to do so by the desire and expectation of successfully forming the non-woven.

Claims 16 and 32 are rejected under 35 USC 103(a) as being unpatentable over Dong in view of Jellinek, as applied to claims 1 and 19, respectively, above, and further in view of Dewsbury (GB 2 292 082).

The combined teaching of Dong in view of Jellinek is detailed above.

Neither of these references explicitly that application of the finishing agent includes applying a scent producing additive.

Dewsbury teaches that a scented coating may be applied to a non-woven to serve as an adhesive [abstract], the scent covering other unpleasant smells associated with application of the non-woven [1:bottom].

It would have been obvious to one of ordinary skill in the art to modify the process of Dong in view of Jellinek so as to include scent into or as the finishing agent.

One of ordinary skill in the art would have been motivated to do so by the desire and expectation of yielding a desirably scented product.

(10) Response to Argument

Appellant's arguments have been fully considered, but the arguments are not persuasive.

The Examiner's position holds that: (a) because Dong teaches the production of decorative laminates, this would have suggested application of the dyes and pigments in any suitable and aesthetically desirable fashion and that doing so would have been obvious to one of ordinary skill in the art; and (b) there is no evidence of record that the binder applicator taught by Dong requires 100% coverage.

With respect to (a), the Examiner agrees with Appellant's assessment of Dong insofar as non-wovens are taught in relation to the underlay, overlay, and/or substrate, but not the decorative layer. It is noted that, with respect to the overlay, Dong teaches:

> ...the overlay should preferably be transparent so that the image of the decorative layer will transmit as intended. [6:29-31, emphasis added]

It is further noted that, with respect to the underlayer, this reference teaches:

> Clarity is not essential in the underlayer, so long as there is no undesired transmittance through the decorative layer. [9:24-26, emphasis added]

Finally, with respect to both the underlayer and the overlay, this reference teaches:

> For example, a colorant, such as a dye or a pigment, in addition to be [*sic*] optionally added to the white-water, can be added in a separate step, for example, above 7 by use of an applicator, such as a binder applicator. [19:14-17]

In the first two passages cited above, the Examiner notes use of the qualifying language "preferably" and "not essential." It is preferable, but not required, that the overlay be transparent. Further, it is preferable, not required, that the underlayer be clear, as long as there is no undesired transmittance of the underlayer's color and/or design through the decorative layer.

The finished product of Dong is a decorative laminate. The mere fact that the finished product is decorative in nature makes the kind and degree of decoration subjective to the desire of the artisan. There is nothing in Dong limiting the kind and degree of decoration in any way. The only decoration explicitly disclosed by the reference, such as a wood-grain appearance [3:28-29], are exemplary and non-limiting [see also 1:7-13 and 3:20-29]. References are part of the literature of the art, relevant for all they contain, may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art, including non-preferred embodiments; non-preferred embodiments do not constitute a teaching away from a broader disclosure or non-preferred embodiments [MPEP 2123]. Consequently, in the production of a decorative laminate in which the artisan intends for the decorative layer to transmit only partially through the overlay, application of a suitable amount and distribution of dye/pigment to the overlay (i.e., in an amount less than 100%) would have been well-within the scope of what is suggested by Dong's broad disclosure. Similarly, in the production of a laminate in which the artisan desires for transmittance of a certain color and/or pattern of the underlayer through the decorative layer, application of a suitable amount and distribution of dye/pigment to the underlayer (i.e., an amount of less than

100%) would have been well-within the scope of what is suggested by Dong's broad disclosure. Finally, the issue of obviousness is not determined by what the references expressly state but what they would reasonably suggest to one of ordinary skill in the art [*In re Siebentritt*, 152 USPQ 618 (CCPA 1967)].

With respect to (b), as noted above, there is no evidence of record that the binder applicator of Dong, the device by which coating material is applied to the underlay, overlay, and/or substrate, is necessarily a disclosure of 100% coverage of the underlay, overlay, and/or substrate. Further, even if application by binder applicator results in 100% coverage, Appellant's claimed range of "less than 100%" is inclusive of coverage amounts infinitesimally smaller than 100%. In *Titanium Metals Corp. of America v. Banner*, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985) it was held that a *prima facie* case of obviousness exists where the claimed ranges and prior art ranges do not overlap but are close enough that one skilled in the art would have expected them to have the same properties. It is the Examiner's position that one of ordinary skill in the art would have expected a finishing agent coverage of 100% (outside of the claimed range) to have the same properties as a finishing agent coverage of 99.999...% (the claimed range) and that there is no evidence or suggestion of the criticality of the latter coverage over the form of record in this application.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/William Phillip Fletcher III/
Primary Examiner

Conferees:

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Quality Assurance Specialist, TC1700